

## REMARKS

This responds to the Office Action mailed on March 24, 2006. Claims 10, 11, 29, 30 and 31 are amended, no claims are canceled, and no claims are added. Thus, claims 1-45 remain pending in this application.

### §112 Rejection of the Claims

Claims 10, 29, 44 and 45 were rejected under 35 U.S.C. § 112, second paragraph. Claims 10, 29, 44 and 45 have been amended to further clarify the recited subject matter. Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of these claims.

### §102 Rejection of the Claims

Claims 1-3, 7-16, 20-26, 28, 31, 32, 36-41 and 43 were rejected under 35 U.S.C. § 102(e) for anticipation by Eriksson et al. (US 6,563,891). Applicant respectfully traverses. Applicant respectfully asserts that the rejection has not provided a *prima facie* case for anticipation, as the rejection relies on inherency for the anticipation rejection and has not provided a *prima facie* case for inherency.

### Requirements for Anticipation under §102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup> The identical invention must be shown in as complete detail as is contained in the claim.<sup>2</sup> The elements must be arranged as required by the claim (not an *ipsissimis verbis* test - identity of terminology is not required).<sup>3</sup>

<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>3</sup> *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Requirements for Inherency

To serve as an anticipating when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.<sup>4</sup> This modest flexibility in the rule that ‘anticipation’ requires that every element of the claims appear in a single reference accommodates situations where the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges.<sup>5</sup> The inherent disclosure must be necessarily present and a person of ordinary skill in the art would recognize its presence.<sup>6</sup>

The §102 Rejection

The rejection states, among other things: *The examiner is interpreting the various modes to be synonymous with the claims language describing protocols, wherein the acquisition, hold and release, relating to a beginning, duration and end, are inherent properties of a finite time frame in which the modes various gains are applied.*<sup>7</sup> Applicant respectfully traverses.

Eriksson et al. identifies a mode involving momentarily switching frequency to that of another cell to measure total signal strength from the other cell, a sleep mode, an awaking from sleep mode, a traffic mode, and an initial acquisition after power-on mode.<sup>8</sup> Applicant respectfully asserts that these operation modes are not synonymous with transmission protocols, as has been asserted in the rejection.

Applicant respectfully traverses the assertion that acquisition, hold, and release are inherent properties of a finite time frame. Acquisition of an incoming signal includes attack (generally an initialization time for a detected signal to transition from a minimum level to a maximum signal level) and lock onto the incoming signal; a hold time is a period of time for which a gain for an incoming signal or a sensitivity for an incoming signal is maintained at a

<sup>4</sup> *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

<sup>5</sup> *Id.* at 1269.

<sup>6</sup> *Crown Operations Intl. v. Solutia, Inc.*, 289 F.3d 1367, 1377 (Fed. Cir. 2002).

<sup>7</sup> *Office Action Dated 03/24/2006*, paragraph 4 (bottom of page 3 to top of page 4).

<sup>8</sup> Eriksson et al., at col. 13 lines 32-63.

relatively constant level; and a release is the release of a hold allowing a gain or sensitivity level to autonomously increase to a level dependent upon detecting an incoming signal.<sup>9</sup>

Further, Applicant respectfully asserts that a person of ordinary skill would not recognize that a control unit having programmable acquisition, hold, and release parameters to manage the acquisition and gain of the wireless signal based on a transmission protocol is necessarily present in Eriksson et al. For example, Eriksson et al. identifies four AGC-related parameters: “n” related to signal-strength measurement smoothing filter time constant; accumulator value (V) for the smoothing filter; “m” related to the AGC control loop speed; and accumulator value (G) related to the current gain setting.<sup>10</sup> Given modes and AGC-related parameters identified in Eriksson et al., Applicant asserts that a person of ordinary skill in the art would NOT recognize that a control unit having programmable acquisition, hold, and release parameters to manage the acquisition and gain of the wireless signal based on a transmission protocol is necessarily present in Eriksson et al.

Applicant respectfully asserts the rejection improperly relies on inherency, and has not provided a *prima facie* case of anticipation under §102. With respect to independent **claim 1**, Applicant is unable to find, among other things, in the cited portion of Eriksson et al. a receiver comprising, among other things, a control unit having programmable acquisition, hold, and release parameters to manage the acquisition and gain of the wireless signal based on a transmission protocol. With respect to independent **claim 14**, Applicant is unable to find, among other things, in the cited portion of Eriksson et al. a system comprising, among other things a control unit having programmable acquisition, hold, and release parameters to manage the acquisition and gain of the wireless signal based on a transmission protocol. With respect to independent **claim 31**, Applicant is unable to find, among other things, in the cited portion of Eriksson et al. a method, comprising among other things, determining whether the detected wireless energy corresponds to a communication session, determining a transmission protocol to operate an automatic gain control for the communication session, and managing the automatic gain control to regulate gain by according to the determined transmission protocol. The dependent claims are asserted to be in condition for allowance for at least the reasons provided with respect to their base claims.

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<sup>9</sup> *Applicant's Specification*, at page 4 lines 9-18.

<sup>10</sup> *Eriksson et al.*, at col. 12 line 59 to col. 13 line 2; FIG. 8.

Applicant respectfully requests withdrawal of the rejection, and reconsideration and allowance of the claims.

*§103 Rejection of the Claims*

Claims 4-6, 17-19, 27, 30, 33-35 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eriksson et al. in view of Rembrand et al. (US 2004/0234089). Applicant respectfully traverses for at least the reasons provided above with respect to §102 rejection in view of Eriksson et al., and respectfully asserts that the combination of Rembrand et al. with Eriksson et al. does not cure the deficiencies of the §102 rejection. These dependent claims are asserted to be in condition for allowance for at least the reasons provided with respect to their base claims.

*Reservation of Rights*

Applicant maintains its right to swear behind any references which are cited in a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a) and 103/102(e). Statements distinguishing the claimed subject matter over the cited reference are not to be interpreted as admission that the references are prior art.

In the interest of clarity and brevity, Applicant has not addressed every assertion made in the office action. Applicant's silence regarding any specific assertion contained in the office action is not intended to be taken as an admission of the assertion.

### **CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6960 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 28<sup>th</sup> day of June, 2006.

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